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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
NAI1P048/01.183.01

I hereby certify that this correspondence is being e-filed with the USPTO

on November 13, 2007

Signature /Dana Chan/

Typed or printed name Dana Chan

Application Number	Filed
10/028,653	12/20/2001

First Named Inventor
James M. Vignoles

Art Unit	Examiner
2137	Pyzocha, Michael J.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the:

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 41,429
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

/KEVINZILKA/
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November 13, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☑ *Total of 1 forms are submitted.

REMARKS

The Examiner has rejected Claim 12 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. More specifically, the Examiner has argued that '[n]owhere in the specification is "A computer program product embodied on a tangible computer readable medium" described.' Applicant respectfully disagrees and points out that Page 8, lines 1-2 of the specification disclose a "Random Access Memory (RAM)" and a "Read Only Memory (ROM)." In addition, applicant notes that Page 8, lines 15-16 of the specification disclose that "[a] preferred embodiment may be written using JAVA, C, and/or C++ language, or other programming languages."

Applicant respectfully asserts that the specification clearly discloses both RAM and ROM which are examples of tangible computer readable mediums, in addition to an embodiment written using a programming language, which is an example of a computer program product. As a result, the above claim complies with the written description requirement. Of course, the foregoing citations are set forth for illustrative purposes only, and should not be construed as limiting in any manner.

The Examiner has rejected Claims 1, 4, 5, 7, 12, 15, 16, 18, 23, 29, and 33-37 under 35 U.S.C. 103(a) as being unpatentable over ConSeal PC FIREWALL Technical Summary (hereinafter ConSeal), in view of Hari et al. (Detecting and resolving packet filter conflicts), in view of Coss et al. (U.S. Patent No. 6,098,172), further in view of Chan et al. (U.S. Patent No. 6,910,028), and further in view of Jacobson (U.S. Patent No. 6,735,701). In addition, the Examiner has rejected Claim 28 under 35 U.S.C. 103(a) as being unpatentable over ConSeal, in view of Hari, in view of Coss, in view of Chan, and in further view of Horvitz et al. (U.S. Patent Application No. 2003/0046421). Applicant respectfully notes that the Examiner has referenced "US 2003021621" when referring to Horvitz et al., which applicant interprets as Horvitz et al. (U.S. Patent Application No. 2003/0046421).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

With respect to the first element of the prima facie case of obviousness and, in particular, the obviousness of combining the aforementioned references, the Examiner has argued that "it would have been obvious... to use Hari et al's priorities... [and] conflict resolution... in the firewall system of ConSeal," and that the "[m]otivation to do so would have been to avoid matching multiple filters with confliction actions (see Hari et al page 1204 section II." To the contrary, applicant respectfully asserts that it would not have been obvious to combine the teachings of the Hari and ConSeal references, especially in view of the vast evidence to the contrary. Applicant's arguments made on page 11, fourth paragraph, through page 13, first paragraph of Amendment E mailed 06/26/2007 are hereby incorporated by reference.

In the Office Action mailed 08/13/2007, the Examiner has argued that "the methods provided by Hari are all conflict resolution schemes" and that "[t]herefore, the methods of Hari prevent multiple matched filters with conflicting actions to be used." Applicant respectfully disagrees and again points out that Hari teaches possible solutions to a situation where a packet flow matches multiple filters, and not "avoid[ing] matching multiple filters with confliction actions" (emphasis added), which is cited as motivation by the Examiner.

Additionally, in the Office Action mailed 08/13/2007, the Examiner has admitted that "[it] may be true" that "the Hari reference teaches a different... method for conflict

resolution that does not use filter prioritization," but has further argued that "the portions relied upon are the filter prioritization methods taught on page 1204." Applicant respectfully disagrees and notes that the filter prioritization methods taught on page 1204 are included in the "implicit conflict resolution schemes" which "do not work in the general case" (Page 1204, Section II – emphasis added). Thus, applicant again respectfully asserts that it would not have been obvious to combine a prioritization technique that "do[es] not work in the general case," as taught in Hari, with that taught by ConSeal, and therefore no suggestion or motivation exists to combine such references.

Furthermore, in the Office Action mailed 08/13/2007, the Examiner has argued that "Hari teaches the benefits of the methods, such as resolving conflicts and that they are simple to implement," and that "therefore Hari fulfills the requirement for some teaching, suggestion, or motivation to do so." Applicant respectfully disagrees and again notes that Hari's disclosure that implicit conflict resolution schemes do not work in the general case in fact *teaches away* from the use of the aforementioned prioritization technique with that taught by ConSeal. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

More importantly, applicant respectfully asserts that the third element of the *prima facie* case of obviousness has also not been met by the prior art reference relied on by the Examiner. For example, with respect to the independent claims, the Examiner has relied on page 1204, section II from the Hari reference to make a prior art showing of applicant's claimed technique "wherein a first policy with a higher priority has a first condition associated therewith that is different from a second condition associated with a second policy with a lower priority such that the first policy and second policy are activated under different priority-related conditions" and "identifying currently executed security actions, determining whether a conflict exists between the currently executed security actions, and resolving any conflicts between the currently executed security actions" (see this or similar, but not necessarily identical language in the independent claims). Applicant's arguments made on page 13, second paragraph, through page 16,

second paragraph of Amendment E mailed 06/26/2007 are hereby incorporated by reference.

In the Office Action mailed 08/13/2007, the Examiner has presented another theoretical example which "extend[s] the example" found in the third paragraph of page 1204, section II of Hari, and has stated that the fabricated example "would be known to one of ordinary skill in the art." More specifically, the Examiner has argued that "if we add $F_3 = (*,*)$ with $A(F_3) = \{500$ Kpbs bandwidth$\}$ with F_1 having the highest priority and F_3 having the lowest, this third filter is well within the scope of [Hari] as [Hari] discloses the use of any number of filters with wildcards (*)." Further, the Examiner has argued that "whenever traffic comes to the filter from the network (128.112.*) destined for the network (128.122.*) there is a conflict between all three filters, [and] since F_1 has the highest priority it will be chosen," and that "[t]herefore, F_1 is chosen under a first priority-related condition." The Examiner has further argued that "when traffic comes to the filter from anywhere but (128.112.*) and is destined to (128.122.*) there is a conflict between F_2 and F_3 and since F_2 has a higher priority it will be chosen" and that "[t]herefore F_2 is chosen under [a] second priority-related condition" (emphasis removed).

Applicant respectfully disagrees and again points out that the above theoretical example fabricated and relied on by the Examiner merely implements one of the three "possible solutions" provided on page 1204 of Hari. More specifically, applicant notes that the Examiner's example merely illustrates two situations in which the same highest priority matching solution is used to determine the appropriate filter. Again, applicant asserts that Hari merely describes three "possible solutions" for "a conflict [when] the packets of the flow match both F_1 and F_2," which does not even *suggest*, and in fact *teaches away* from, a technique "wherein a first policy with a higher priority has a first condition associated therewith that is different from a second condition associated with a second policy with a lower priority such that the first policy and second policy are activated under **different** priority-related conditions" (emphasis added), as claimed by applicant. Clearly, the disclosure of only using the matching filter with the highest

priority, as in Hari, simply fails to even suggest a technique "wherein ... the first policy and second policy are activated under **different** priority-related conditions" (emphasis added), as claimed.

In addition, with respect to the independent claims, the Examiner has relied on Col. 7, line 60 – Col. 8, line 33 from Chan to make a prior art showing of applicant's claimed technique "wherein the conditions are based on a source of the policies" (see this or similar, but not necessarily identical language in the independent claims). Applicant's arguments made on page 16, fourth paragraph, through page 17, third paragraph of Amendment E mailed 06/26/2007 are hereby incorporated by reference.

In the Office Action mailed 08/13/2007, the Examiner has reiterated the argument stated in the Office Action mailed 03/26/2007 and has additionally argued that "each policy in the modified system is activated based on a condition that is based on a priority... as taught by Hari in the modified system" and that "Chen teaches that polic[ies] each have a priority based on [their] source." The Examiner further asserts that "[t]herefore the modified system teaches that the conditions are based on a source of the policies" (emphasis removed). Applicant respectfully disagrees and notes that the excerpt from Hari relied on by the Examiner merely describes three "possible solutions" for a conflict when packets of a flow match multiple filters, and not a policy activated based on a condition that is based on a priority, as asserted by the Examiner. Further, applicant again notes that Chen merely discloses that "the merge policy may specify that the relative priority of rules is based on relative authority level of the originating source application **of those rules**" (emphasis added). However, merely disclosing that a policy specifies that the priority of rules is based on the authority level of the source application of the rules does not even *suggest* a technique "wherein the conditions are based on a source of the policies" (emphasis added), as claimed.

Thus, a notice of allowance or a proper prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.